

REMARKS

As an initial matter, the Applicant thanks the Examiner for his thorough review of the present application. In the outstanding Office Action, the Examiner has rejected claims 14-24 under 35 U.S.C. §103 in view of several references. In response, the Applicant has amended the claims and cancelled claim 22. As such, claims 14-21 and 23-24 are currently presented for prosecution in this Application. In view of Applicant's claim amendments and remarks, Applicant respectfully submits that the pending claims are in condition for allowance. Accordingly, Applicant respectfully requests that the present Response be considered and entered, the rejections to the claims be withdrawn, and that the case now be passed to issue.

I. Examiner Interview

The Applicant thanks the Examiner for his telephone interview of August 9, 2006. During the interview, the Applicant stated that it believed that its invention as a whole was not disclosed or suggested by the cited references. Applicant also stated it would amend the claims to clarify its invention and distinguish it from the references especially Hamm, et al (4,217,537), Leininger (4,687,922) and Steele (4,870,811). The Applicant also discussed the claim term "plug socket" and the Examiner's repeated drawing objection. The Examiner stated that he would fully consider the Applicant's amendments and arguments.

II. Claim Amendments

The Applicant has amended the claims to clarify its invention. Specifically, the Applicant has amended many of the claims to clarify the function of the "plug socket," that the cutting tool is capable of operating simultaneously with an external electrical accessory, that the plug socket is capable of inductive electrical energy transfer increasing the operational safety of the saw, and that the external electrical accessory is secured to the housing of the saw. The Applicant has also added the limitation of an electrical component arranged between the generator and plug socket which is selected from the group consisting of a switch, a rectifier element, and an overvoltage protection element. No new matter has been entered.

III. Drawing Objections

The Examiner has again objected to the drawings under 37 C.F.R. 1.83(a) for not showing the "plug socket", described on the second to last paragraph on page 3 of the specification. The Examiner has also stated that this objection concerns the drawing itself, and not the specification. As mentioned in the telephone interview, the Applicant notes that the figures show a "plug socket" as claimed, in that they depict a "plug socket" with a plug attached or secured to the socket. The Applicant further believes that the terms "plug" and "socket" are well known in the art and that "socket" conventionally refers to a connector with a female receptor. Applicant does not believe that a new drawing showing the plug socket without the plug attached is necessary and requests reconsideration of the objection. Should the objection be maintained, however, the Applicant will submit a new drawing as described above.

IV. Claim Rejections – 35 USC §112

The Examiner rejects claims 1 and 6 and 11 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner alleged that the phrase "plug socket" in claims 14, 16, 17, 20, 21 and 24 is vague and indefinite as it is unclear whether the "plug socket" refers to a plug or a socket.

In response, Applicant has amended the above claims to clarify that the "plug socket" removably accepts a plug of an external electrical accessory. The Applicant believes that this amendment overcomes the rejection and respectfully requests reconsideration and withdrawal.

Additionally, the Examiner rejects claims 17 and 21 as they contain the recitation that the "combustion engine selectively powers both said cutting tool and said plug socket" without containing the recitation of a generator. In response, the Applicant has added a generator to these claims and respectfully requests reconsideration.

V. *Claim Rejections – 35 U.S.C. §103*

a. **Hamm et al (4,217,537)**

The Examiner rejects claims 14-24 under 35 U.S.C. § 103(a) as being unpatentable over Hamm. In response, the Applicant has amended the independent claims 14, 17 and 21 to clarify that the “cutting tool is capable of operating simultaneously with an external electrical accessory.”

Hamm does not teach, disclose or suggest the above-referenced recitation. Indeed, Hamm is directed to a chain saw driven generator in which the generator is assembled by first disassembling the chain saw, equipping the engine unit 14 with a pulley, and then mounting the engine unit to a generator 12. (Hamm, col. 3, lines 49-59; FIGS. 1, 2, and 4.) As such, the cutting tool cannot be operated while the device is functioning as a generator. Moreover, Hamm is directed primarily to a generator for charging car batteries where there is no need to operate a chain saw and generator at the same time and therefore no suggestion or motivation to do so. (Hamm, col. 1, lines 1-68).

In view of the above, Applicant respectfully requests withdrawal of the outstanding rejection of claims 14, 17 and 21 and the claims that depend therefrom.

b. **Nagashima (4,654,907) in view of Leininger (4,678,922)**

The Examiner rejects claims 14-24 under 35 U.S.C. § 103(a) for allegedly being obvious over Nagashima in view of Leininger. This rejection is predicated on Applicant’s remarks in which it referred to reference number 104 in FIG. 1 as showing the “plug socket.”

As an initial matter, the Applicant notes that it uses the terms “plug” and “socket” as conventionally defined, that is, a “plug” has a male connector and is removably attached to a “socket” which has a female connector. According to MPEP § 2173.02, some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire. Moreover, if claims could reasonably apprise those skilled in the art both of the

utilzaton and scope of the invention, the statute demands no more. Id. Here, Applicant believes that one of ordinary skill in the art would know that that the "plug" "socket" and "plug socket" used in the application have their conventional meanings.

Notwithstanding the above, the Applicant has amended claims 14, 17 and 21 to clarify that the "plug socket" is for "removably accepting a plug of an external electrical accessory" (emphasis added). This recitation is neither taught nor suggested by the combination of Nagashima and Leininger. Leininger does not contain such a plug socket, it contains a lamp 28 on a gooseneck 30 that is "physically connected" to the casing 14 of the tool. (Leininger, col. 2, lines 60-68.) There is no mention of the terms "plug" or "socket" or depiction of such an arrangement, and Applicant believes the "physical connection" to be permanent not removable. Applicant also notes that Leininger does not address removing the lamp 28 for any reason and contains no suggestion that removal is a desirable.

Additionally, neither Leininger's drawings nor Leininger's specification suggests the possibility that a plug socket (or the like) may be provided to Leininger's housing so as to power a wide variety of external electrical accessories. Thus, Leininger's teaching is limited to the very narrow application of a tool capable of powering a dedicated electrical device; Leininger does not, therefore, reflect any appreciation, or provide any solution, for the desire to provide a plug socket for the powering a variety of electrical accessories, as is addressed by the present invention. Nagashima adds nothing to the teachings of Leininger with respect to the plug socket as it does not contain this limitation.

Applicant also notes that Nagashima and Leininger do not disclose, teach or suggest the other recitations the Applicant added to the claims. Specifically the references to do teach or suggest a cutting tool is capable of operating simultaneously with an external electrical accessory, a plug socket that is capable of inductive electrical energy transfer increasing the operational safety of the saw, and an external electrical accessory that is secured to the housing of the saw. Futher the combination does not disclose or suggest an electrical component arranged between a generator and plug

socket which is selected from the group consisting of a switch, a rectifier element, and an overvoltage protection element.

In view of the above, Applicant respectfully requests withdrawal of the outstanding rejection of claims 14-21, 23-24.

c. Nagashima (4,654,907) in view of Steele (4,870,811)

The Examiner has rejected claims 14-24 under §103 over Nagashima in view of Steele. The Applicant believes that Steele is a prime example of why the invention as claimed is patentable. That is, Steele was allowed even though lawnmowers and generators were well known at the time. The same rationale should be applied to the present application, e.g., that the references, Nagashima, Steele, Hamm and Leininger, alone or in combination, do not disclose teach or suggest the invention *as a whole*. None of these references teach or suggest the counter-intuitive idea of placing an external electrical accessory, such as light, on a gasoline powered chainsaw via a plug socket.

Moreover, Applicant's amended claims contain numerous limitations not present in the combination of Nagashima and Steele. Nagashima and Steele do not disclose, teach or suggest a cutting tool that is capable of operating simultaneously with an external electrical accessory, or a chain saw with a combustion engine that powers a generator. Steele discloses a portable gasoline powered generator with two or more a.c. electrical units; one for powering an *electrically* powered lawn mower and another for powering an electrical auxiliary device like a hand tool (Steele, Abstract). As such, Steele is nothing more than a portable generator that one can place on top of an electric lawnmower. Moreover, Steele discloses use of its generator with a lighting system only when the apparatus has been *removed* from the lawnmower. (Steele, Abstract).

In contrast, the claimed invention is a gasoline powered chain saw with a combustion engine. The saws own combustion engine powers the generator which powers the plug socket and allows use of an external electrical device such as a lamp. Moreover, Steele does not disclose or suggest an external electrical accessory that is secured to a chainsaw.

Applicant further notes that Nagashima and Steele do not disclose, teach or suggest the other recitations the Applicant added to the claims. The combination does not disclose or suggest, among other things, an electrical component arranged between a generator and plug socket which is selected from the group consisting of a switch, a rectifier element, and an overvoltage protection element.

In view of the above, Applicant respectfully requests withdrawal of the outstanding rejection of claims 14-21, 23-24.

CONCLUSION

In view of the remarks above, it is respectfully submitted that claims 14-24 are allowable, and an early action to that effect is earnestly solicited.

The Examiner is invited to contact the undersigned at the number below to expedite resolution of any issues that the Examiner may consider to remain unresolved. In particular, should a Notice of Allowance not be forthcoming, the Examiner is requested to phone the undersigned for a telephonic interview, an Examiner's amendment, or the like, while the outstanding issues are fresh in the mind of the Examiner.

It is believed that no additional fees or deficiencies in fees are owed. However, authorization is hereby given to charge our Deposit Account No.13-0235 in the event any additional fees are owed.

Respectfully submitted,

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